



APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

08/287,290 06/07/95 WEISOMANN C B6/B12-DIV3

JAMES F. HALEY JR.  
FISH AND NEAVE  
1281 AVENUE OF THE AMERICAS  
NEW YORK, NY 10020-1104

10N2/0915

EXAMINER
----------

MARTINELL, J

ART UNIT	PAPER NUMBER
----------	--------------

1804

8

DATE MAILED: 09/15/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6/19/97
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 37-55 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 37-55 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Serial No. 08/487,280

Art Unit 1804

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 39 and 53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 06/223,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because the

Serial No. 08/487,280

Art Unit 1804

sequences in the claims are the same. This rejection is repeated for reasons already of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 40 and 54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 06/223,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because the sequences in the claims are the same. This rejection is repeated for reasons already of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 41 and 55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application No.

Serial No. 08/487,280

Art Unit 1804

06/223,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because the sequences in the claims are the same. This rejection is repeated for reasons already of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 37, 38, and 42-52 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-7, 43, and 44 of copending Application No. 06/223,108 in view of Claims 1-18 of U.S. Patent No. 4,530,901 (Weissmann). Claims 5-7, 43, and 44 of copending 06/223,108 disclose the same DNA sequences as are used in the instant claims. The Weissmann patent claims vectors, host cells, and the use of vectors and host cells that require the same gene expression control elements as are required in the instant claims. It would have been obvious for one of ordinary skill in the art to use the gene control elements and host cells

Serial No. 08/487,280

Art Unit 1804

in the claims of the Weissmann patent to express the DNA sequences claimed in copending Serial No. 06/223,108 in order to make large amounts of human  $\alpha$ -IFN. This rejection is repeated for reasons already of record.

This is a provisional obviousness-type double patenting rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37, 42-44, 46, 47, and 49 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Nagata et al (Nature 284: 316 (1980)). The claims are embraced by the DNAs, vectors, and host cells of Nagata et al in that the claims also embrace DNAs that encode mature  $\alpha$ -IFNs. Applicant cannot rely on foreign priority document EP 80300079.3 because the foreign priority document does not disclose the difference between mature  $\alpha$ -IFN and pre  $\alpha$ -IFN. The signal sequence for  $\alpha$ -IFN is disclosed in Nagata et al at pages 319 and 320. Applicant's arguments (paper no. 7, pages 5-6) and the declaration by Dr. Weissmann

Serial No. 08/487,280

Art Unit 1804

filed June 19, 1997 are not sufficient to overcome this rejection because the signature on the declaration appears to be a xerographic copy and not an original signature.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed

Serial No. 08/487,280

Art Unit 1804

to Art Unit 1804 at (703) 308-4242. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.

  
JAMES MARTINELL, PH.D.  
SENIOR LEVEL EXAMINER  
GROUP 1800